



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,821	11/24/2003	Douglas B. Wilson	114089.120	5355
23483	7590	11/20/2009		
WILMERHALE/BOSTON 60 STATE STREET BOSTON, MA 02109			EXAMINER LUONG, VINH	
			ART UNIT 3656	PAPER NUMBER
			NOTIFICATION DATE 11/20/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

michael.mathewson@wilmerhale.com
teresa.carvalho@wilmerhale.com
sharon.matthews@wilmerhale.com

Office Action Summary	Application No. 10/720,821	Applicant(s) WILSON, DOUGLAS B.	
	Examiner Vinh T. Luong	Art Unit 3656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Appendixes 1-3</u> . |

Art Unit: 3656

1. A request for continued examination (RCE) under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on September 24, 2009 has been entered.

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter, such as, “a *first* first section” (emphasis added), “a *second* first section,” “a *first* second section,” and “a *second* second section” in claim 27. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction is required.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claim 28/20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 28/20 recites the limitation “the first and second first *sections*” (plural, emphasis). There is insufficient antecedent basis for this limitation in the claim. As noted, claim 20 recites “a first *section*” (singular, emphasis).

5. Claims 20-26 and claim 28/20, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Anson (US 2,134,020).

Art Unit: 3656

Claim 20

Anson teaches a fatigue relieving/preventing apparatus associated with a steering wheel 10 for controlling a vehicle comprising:

a first section 13 that connects to a peripheral portion of the steering wheel 10;

a second section 11 extends from the first section at the peripheral portion of the steering wheel 10, the second section 11 extends from the first section 13 outward at an angle (α in Fig. 8 of Appendix 1 hereinafter "App. 1") to a plane (App. 1) across a face (App. 1) to the steering wheel 3, the second section 11 being capable of providing resting support for at least a portion (e.g., the hand) of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section 11 is less than the pressure for deforming the second section 11 out of interference with the vehicular operator's ability to operate the steering wheel 10, and deforming out of interference with the vehicular operator's ability to operate the steering wheel 10 when pressure from the portion of the vehicular operator's body on the second section 11 is equal to or greater than the pressure for deforming the second section 11 out of interference with the vehicular operator's ability to operate the steering wheel 10. Anson, p. 1, left col., l. 6 - right col., l. 53.

Claim 21

The second section 11 is deformable in at least one direction when deforming pressure is applied to such second section 11 since it is made of a flexible material such as rubber or similar pliable composition material. Anson, p. 1, right col., ll. 50-53.

Claim 22

Art Unit: 3656

The second section 11 provides resting support for a portion of the vehicular operator's body when resting support pressure from such body portion is applied in at least one direction. Anson, p. 1, left col., ll. 1-43.

Claim 23

The steering wheel 10 includes a steering wheel for controlling at least a nautical vessel, an aircraft, or a ground transportation vehicle.

Claim 24

The second section 11 will return to an original first position after deforming pressure is removed therefrom since it is made of a flexible material such as rubber or similar pliable composition material. Anson, p. 1, right col., ll. 50-53.

Claim 25

The portion of the body supported by the second section includes at least a forearm, wrist, or hand.

Claim 26

The first section 13 extends a length of a predetermined peripheral portion of the steering wheel 10.

Claim 28/20

The first section 13 is deformable since it is made of a flexible material such as rubber. Anson, p. 2, left col., ll. 35-72.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 3656

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 27 and 28/27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anson taken with or without Gemma (US 2002/0162416 A1 cited in European Search Report).

Claims 27 and 28/27

Anson teaches the invention substantially as claimed. However, Anson teaches one first deformable section 13 and one deformable second section 11.

It would have been obvious to one having ordinary skill in the art to change Anson's one deformable first section to at least two deformable first sections (*i.e.*, the first first section and the second first section) and Anson's one second section to at least two second sections (*i.e.*, the first second section and the second second section) in order to relieve fatigue to the vehicle operator as taught or suggested by common knowledge in the art. The number of deformable first sections and second sections would have been a matter of choice in design since the claimed structures and the function they perform are the same as the prior art. See *In re Chu*, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995) citing *In re Gal*, 980 F.2d 717, 719, 25 USPQ2d 1076, 1078 (Fed. Cir. 1992) and *Sjolund v. Musland*, 6 USPQ2d 2020, 2026 (Fed. Cir. 1988)(to change a single panel to a plurality of panels is obvious).

Art Unit: 3656

Alternatively, Gemma teaches at least two deformable first sections (*i.e.*, the first first section and the second first section connected to the rim/peripheral portion 14 of the steering wheel 12, see Appendix 2 hereinafter “App. 2” and Gemma, ¶¶ 24-26) and at least two second sections (*i.e.*, the first second section 16, 26 and the second second section 16, 26 squeezed by the vehicle operator) in order to relieve fatigue to the vehicle operator. Gemma, Summary of the Invention.

It would have been obvious to one having ordinary skill in the art to change Anson’s one first section to at least two first sections and Anson’s one second section to at least two second sections in order to relieve fatigue to the vehicle operator as taught or suggested by Gemma. The modification of Anson’s apparatus by changing the number of the first and second sections as taught or suggested by Gemma would not have been uniquely challenging to a person of ordinary skill in the art because it is no more than “the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement” *KSR Int’l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) and it “does no more than yield predictable results.” *KSR* at 1739.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 20 and 27, and claim 28/27, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Gemma (US 2002/0162416 A1 filed on May 7, 2001).

Art Unit: 3656

Claim 20

Gemma teaches a fatigue relieving/preventing apparatus associated with a steering wheel 12 for controlling a vehicle comprising:

a first section (App. 2) that connects to a peripheral portion of the steering wheel 12 (Gemma, ¶26);

a second section 16, 26 extends from the first section (App. 2) at the peripheral portion of the steering wheel 12, the second section 16, 26 extends from the first section (App. 2) outward at an angle (α in FIGS. 2 and 3 of App. 2) to a plane (App. 2) across a face (Att. 2) to the steering wheel 12, the second section 16, 26 being capable of providing resting support for at least a portion (*e.g.*, the hand) of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section 16, 26 is less than the pressure for deforming the second section 16, 26 out of interference with the vehicular operator's ability to operate the steering wheel 12, and deforming out of interference with the vehicular operator's ability to operate the steering wheel 12 when pressure from the portion of the vehicular operator's body on the second section 16, 26 is equal to or greater than the pressure for deforming the second section 16, 26 out of interference with the vehicular operator's ability to operate the steering wheel 12.

Gemma, ¶¶ 8, 24, and 26.

Claim 27

Gemma teaches a fatigue relieving/preventing apparatus associated with a steering wheel 12 for controlling a vehicle comprising:

at least a first first section (FIG. 1) and a second first section (FIG. 1) that connect to a peripheral portion/rim of the steering wheel 12 (Gemma, ¶ 26); and

Art Unit: 3656

at least a first second section 16, 26 (FIG. 1) and a second second section 16, 26 (FIG. 1) that connect to, and extends from the first and second first sections (FIG. 1), respectively, with the first and second second sections 16, 26 extending from the respective first and second first sections outward at an angle (α in FIGS. 2 and 3 of App. 2) to a plane (App. 2) across a face to the steering wheel 12, the first and second second sections 16, 26 each providing resting support for at least a portion of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the first or second second section 16, 26 is less than the pressure for deforming the first or second second section 16, 26 out of interference with the vehicular operator's ability to operate the steering wheel 12, and deforming out of interference with the vehicular operator's ability to operate the steering wheel 16, 26 when pressure from the portion of the vehicular operator's body on the first or second second section 16, 26 is equal to or greater than the pressure for deforming the first or second second section 16, 26 out of interference with the vehicular operator's ability to operate the steering wheel 12.

Claim 28/27

The first and second first sections are deformable. Gemma, ¶ 24.

11. Claim 20 is rejected under 35 U.S.C. 102(b) as being anticipated by Park (US 5,207,713).

Park teaches a fatigue relieving/preventing apparatus 10 associated with a steering wheel 1 for controlling a vehicle comprising:

a first section 60 (see, e.g., FIGS. 1-7 and c. 2, ll. 53-62) that connects to a peripheral portion 2 of the steering wheel 1;

a second section 20 extends from the first section 60 at the peripheral portion 2 of the steering wheel 1, the second section 20 extends from the first section 60 outward at an angle

Art Unit: 3656

(see, e.g., angle α in Fig. 2A of Appendix 3 hereinafter “App. 3”) to a plane (App. 3) across a face (App. 3) to the steering wheel 1, the second section 20 being capable of providing resting support for at least a portion (e.g., the hand) of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section 20 is less than the pressure for deforming the second section 20 out of interference with the vehicular operator's ability to operate the steering wheel 1, and deforming out of interference with the vehicular operator's ability to operate the steering wheel 1 when pressure from the portion of the vehicular operator's body on the second section 20 is equal to or greater than the pressure for deforming the second section 20 out of interference with the vehicular operator's ability to operate the steering wheel 1.

Park, claims 1-15.

12. Claims 20-26 and claim 28/20, as best understood, are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-17, 24, and 27 of copending Application No. 10727306 (Appl.’306).

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 20-26 and 28/20 of this application and claims 14-17, 24, and 27 of Appl.’306 claim common structures such as a first section and a second section connected to the first section. To the extent that claims 14-17, 24, and 27 in Appl.’306 call for the second section being rigid, semi-rigid or flexible, or *non-deformable*, meanwhile, claims 20-26 and 28/20 in this application call for the second section being *deformable*, however, the terms rigid, semi-rigid, flexible, non-deformable, and/or deformable are relative terms. In fact, when the second section is rigid, semi-rigid or flexible, it is inherently deformable if enough pressure is applied to it. See *Fredman v. Harris-Hub Co., Inc.*, 163 USPQ 397 (DC 1969)(“Flexibility” and “rigidity” are

Art Unit: 3656

relative terms, particularly since virtually anything will flex if enough pressure is applied to it.). On the other hand, it is well settled that selection of known material suitable for its intended purpose would have been obvious. *In re Leshin*, 125 USPQ 416 (CCPA 1960) and MPEP § 2144.07.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the material of the second section claimed in claims 14-17, 24, and 27 of Appl.'306 such that it is deformable as claimed in claims 20-26 and 28/20 of this application in order support a portion of the vehicular operator's body as taught or suggested by common knowledge in the art. *In re Leshin, supra*.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Claims 27 and 28/27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18 and 19/18 of copending Application No. 10727306 (Appl.'306).

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 27 and 28/27 of this application and claims 18 and 19/18 of Appl.'306 claim common structures such as at least two second sections (i.e., a first second section and a second second section) that each connected to the first section at separate location. To the extent that claims 18 and 19/28 in Appl.'306 call for the second section being rigid, semi-rigid or flexible, or *non-deformable*, meanwhile, claims 27 and 28/27 in this application call for the second section being *deformable*, however, the terms rigid, semi-rigid, flexible, non-deformable, and/or deformable are relative terms. In fact, when the second section is rigid, semi-rigid or

Art Unit: 3656

flexible, it is inherently deformable if enough pressure is applied to it. See *Fredman v. Harris-Hub Co., Inc.*, 163 USPQ 397 (DC 1969) (“Flexibility” and “rigidity” are relative terms, particularly since virtually anything will flex if enough pressure is applied to it.). On the other hand, it is well settled that selection of known material suitable for its intended purpose would have been obvious. *In re Leshin*, 125 USPQ 416 (CCPA 1960) and MPEP § 2144.07.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the material of the at least two second sections claimed in claims 18 and 19/18 of Appl.’306 such that it is deformable as claimed in claims 28 and 28/27 of this application in order support a portion of the vehicular operator’s body as taught or suggested by common knowledge in the art. *In re Leshin, supra*.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

14. Applicant's arguments filed September 24, 2009 have been fully considered but they are not persuasive.

Applicant contended that the bulbular-formed grip portion 11 of Anson does not provide “resting support” for the driver's body; that is provided by the driver’s lap. Amend. p. 6.

At the outset, Applicant’s claims are drawn to an apparatus, not a process of using. It is well settled that the claims drawn to an apparatus must distinguish from prior art in terms of structure rather than function. *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997); *In re Danly*, 120 USPQ 528 (CCPA 1959); *Ex parte Masham*, 2 USPQ2d 1647 (BPAI 1987); and MPEP § 2114. The Court in *Schreiber* has laid Applicant’s arguments to rest by pointing out that: “[a]lthough Schreiber is correct that Harz does not address the use of the disclosed structure to

Art Unit: 3656

dispense popcorn, *the absence of a disclosure relating to function does not defeat the Board's finding of anticipation.*" The Court in *Schreiber* emphasized:

A patent applicant is free to recite features of an apparatus either structurally or functionally. See *In re Swinehart*, 439 F.2d 210, 212, 169 USPQ 226, 228 (CCPA 1971) ("*[T]here is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims.*"). Yet, choosing to define an element functionally, i.e., by what it does, carries with it a risk. As our predecessor court stated in *Swinehart*, 439 F.2d at 213, 169 USPQ at 228:

where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

See also *In re Hallman*, 655 F.2d 212, 215, 210 USPQ 609, 611 (CCPA 1981); *In re Ludtke*, 441 F.2d 660, 663-64, 169 USPQ 563, 565-67 (CCPA 1971).

Moreover, it is well settled that words of the claim are generally given their ordinary and customary meaning, unless it appears from the written description that they were used differently by the applicant. See *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1325, 63 USPQ2d 1374, 1381 (Fed. Cir. 2002), *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001), *Merck & Co. v. Teva Pharmaceuticals USA Inc.*, 73 USPQ2d 1641 (Fed. Cir. 2005), *Phillips v. AWH Corp.*, 415 F.3d 1303, 1320 (Fed. Cir. 2005) *en banc* and MPEP § 2111.

In the instant case, the functional limitation asserted by Applicant is an inherent characteristics of the prior art Anso. In fact, as described in Anso's specification, the bulbular-formed grip portion 11 is comfortably gripped by the hand of the driver (Anso, p. 1, left col., ll.

Art Unit: 3656

26-43). When the driver's hand grips the portion 11, the driver's hand must place or lay his/her hand on the portion 11. The common dictionary, such as, *Merriam-Webster's Collegiate Dictionary* defines "rest" as "[t]o place on or against a support." Hence, when the driver places his/her hand on the portion 11, the driver "rests" his/her hand on the portion 11 as evidenced by the ordinary and customary meaning of the term "rest" in dictionary. Simply put, Anson's second section inherently provides resting support for at least the hand, *i.e.*, the portion of the vehicle operator's body as claimed.

For the reasons set forth above, Applicant's request to withdraw the anticipation rejection of claims 20-16 and 28/20 based on Anson is respectfully declined as a matter of law.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vinh T Luong/
Primary Examiner, Art Unit 3656